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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,810	02/27/2002	Joseph Garner	1001.1495101	6541

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EXAMINER	
SAM, CHARLES H	

ART UNIT	PAPER NUMBER
3731	7

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/083,810	GARNER ET AL.	
	Examiner	Art Unit	
	Charles H. Sam	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

called Jim Rogers on 10/1/03

1)☒ Responsive to communication(s) filed on *27 February 2002* .

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *5,8,9,12-16 and 19-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,7,10,11,17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-21, drawn to a filter system, classified in class 606, subclass 200.

II. Claims 22-29, drawn to a method for retrieving an intravascular filter from a body lumen, classified in class 604, subclass 49.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as a filter system comprising a dilator tip with no conical shaped distal portion.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Upon the election of the product claims, a further election of the species is required.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Fig. 1,2

Species II: Fig. 3,4

Species III: Fig. 5,6

Species IV: Fig. 7

Species V: Fig. 8

Species VI: Fig. 9

Species VII: Fig.10

Species VIII: Fig. 11

Species IX: Fig. 12

Species X: Fig. 13

Species XI: Fig. 14

Species XII: Fig. 15

Species XIII: Fig. 16

Species XIV: Fig. 17

Species XV: Fig. 18

Species XVI: Fig. 19

Species XVII: Fig. 20,23

Species XVIII: Fig. 21,24

Species XIX: Fig. 22,25

Species XX: Fig. 26

Species XXI: Fig. 27

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Glenn M. Seager on 8/13/03 a provisional election was made without traverse to prosecute the invention of the filter system, species I, claims 1-4,6,7,10,11,17 and 18. Affirmation of this election must be

made by applicant in replying to this Office action. Claims 5,8,9,12-16, and19-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Cathcart et al. (6,165,179). Cathcart discloses a filter system comprising a wire 31 having a proximal end and a distal end, a filter 23 for collecting debris from a body lumen, an outer shaft 13, and a dilator tip 20 slidably disposed in the distal sheath and movable between a distally advanced position and a proximally retracted position.

Regarding claim 2, Cathcart discloses a dilator tip 20 comprising a generally circular cross section and a conical shaped distal portion.

Regarding claim 3, Cathcart discloses a resilient inner shaft 17 disposed in the outer shaft 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4,17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Cathcart et al. (6,165,179) in view of Cassell et al. (5,827,324). Cassell discloses a distal portion 50 which is formed of a coil 68 which is encapsulated in a polymer material 70. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the device of Cathcart (inner shaft 17) by including a coil spring inside a polymer material to provide stiffening member with contraction and extension forces.

Claims 7,10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cathcart et al. (6,165,179) in view of Tsugita et al. (5,911,734). Tsugita discloses a filter system comprising a filter 203, an elongate member 207 slidably received within sheath 201, and a coil spring 206 disposed helically about elongate member 207. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the device of Cathcart by providing a coil spring around the inner member 17 to provide the sliding motion of the dilator tip 20.

Regarding claim 7, Tsugita discloses the inner shaft 201 substantially shorter than the length of the outer shaft 211. See Fig. 15.

Regarding claim 10, Tsugita discloses a resilient member 211 disposed about the inner shaft 201.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H. Sam whose telephone number is (703) 305-5650. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

chs
September 3, 2003

MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700